

### **III. Applicant's Arguments**

The specification has been amended in order to incorporate section headings, to include the priority claim, and to incorporate subject matter from the original claims and the original abstract. A substitute specification in compliance with 37 C.F.R. 1.125 is attached to incorporate the changes summarized above. The attached substitute specification contains no new matter.

By the present paper, claims 1-5, 10-16 and 18 have been amended, and new claims 19-21 have been added. More specifically, independent claim 1 has been amended to improve grammar, punctuation and form, which has no further limiting effect on the scope of claim 1. Claim 1 has been further amended to recite

“a means for detecting that comprises an electronic processing unit operably connected to receive signals from the touch sensitive sensors and to detect the speed of a user's finger over said outer element or the actuation frequency of successive touch sensitive sensors,”

as supported by page 4, lines 7-16, and by page 6, line 33, to page 7, line 3, and by Figure 7, of Applicant's disclosure as originally filed.

Claims 2-5, 10-16 and 18 have been amended to improve grammar, punctuation and/or form, and not for a reason related to patentability. Therefore, the present amendment has no further limiting effect on the scope of claims 2-5, 10-16 and 18.

Claims 3 and 4 have been further amended so that they are no longer multiply dependent claims. New claims 19 and 20 have been added to recite the embodiments deleted from claims 3 and 4, respectively.

New independent claim 21 corresponds to previous claim 1 rewritten to improve grammar, punctuation and form, and to replace the phrase “means for detecting” by the

word --detector-- so that so that the limitation does not invoke 35 U.S.C. § 112, sixth paragraph.

The present amendment adds no new matter to the above-captioned application.

**A.     The Invention**

The present invention pertains broadly to a watch that can be used to control movement of a cursor on a computer screen. In accordance with an embodiment of the present invention, a watch is provided that has features recited by independent claim 1. In accordance with another embodiment of the present invention, a watch is provided that has features recited by independent claim 10. In accordance with still another embodiment of the present invention, a watch is provided that has features recited by independent claim 13. In accordance with yet another embodiment of the present invention, a watch is provided that has features recited by independent claim 21. Various other embodiments, in accordance with the present invention, are recited by the dependent claims.

An advantage provided by the various embodiments of the present invention is that a watch is provided that may be operated to control the cursor on a computer screen.

**B.     The Rejections**

Claims 1-5, 7, 8, 11, 12 and 14-18 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite.

In view of the present amendment, Applicant respectfully traverses the rejection and requests reconsideration of the application for the following reasons.

**C. Applicant's Arguments**

As an initial matter, no rejection currently stands against independent claims 11 and 13. Therefore, claims 11 and 13 are in condition for allowance for the reasons of record.

**i. The Section 112 Rejection**

Claims 1-5, 7, 8, 11, 12 and 14-18 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite because the means-plus-function limitation recited by claim 1, namely, the “means for detecting the speed of a user’s finger over said outer element or the actuation frequency of successive sensors,” has been construed by the Board of Patent Appeals and Interferences (hereafter, the “Board”) as a limitation invoking 35 U.S.C. § 112, sixth paragraph, and the Board contends that Applicant’s specification fails to identify “the specific structure which performs the function of determining speed or frequency” (See Decision on Appeal, at 8, lines 6-21). The “means for detecting,” in amended claim 1, cannot be reasonably construed as invoking 35 U.S.C. § 112, sixth paragraph, because it is now defined in terms of a particular structure, namely, an “electronic processing unit” and not merely by the function carried out by the means.

An element provided with a detailed recitation of its structure cannot be construed as invoking interpretation under 35 U.S.C. § 112, sixth paragraph. Cole v. Kimberly-Clark, 102 F.3d 524, 530-531 (Fed. Cir. 1996). In this case, the “means for detecting” is defined as “compris[ing] an electronic processing unit operably connected to receive signals from the touch sensitive sensors....” As is known by those of ordinary skill in the

art, a “processing unit” is a “[p]art of a processor which carries out operations on the data” (See, e.g., ILLUSTRATED PROFESSIONAL DICTIONARY OF HOROLOGY I + II 1123 (2002), a copy of which is filed herewith).

Applicant’s original specification, at 6, line 33, to page 7, line 3, and Applicant’s original Figure 7, establish that, in accordance with the invention, the “electronic processing unit 50” is a part of the electronic movement (48) and is electrically connected to receive electronic signals (i.e., data signals) from the touch sensitive sensors. As described by Applicant’s original specification, at 4, lines 7-16, the speed at which successive sensitive pads are actuated may be detected by differentiating the level of actuation of each touch sensitive sensor. As evident from page 4, lines 7-16, and page 6, line 33, to page 7, line 3, of Applicant’s written description, the processing of data described on page 4, lines 7-16, is handled by the electronic processing unit (50), which is connected to receive data signals from the touch sensitive sensors as described in Figure 7.

For all of the above reasons, the “means for detecting” limitation of amended claim 1 is now defined in terms of detailed structure, and should not be construed under 35 U.S.C. § 112, sixth paragraph. Furthermore, claim 1, as amended, “particularly point[s] out and distinctly claim[s] the subject matter which the applicant regards as his invention” in compliance with 35 U.S.C. § 112, second paragraph.

#### **IV. CONCLUSION**

In view of the present amendment, claims 1-5, 7, 8 and 10-21 are in compliance with 35 U.S.C. § 112. No rejections based on prior art currently stand against the claims of the above-captioned application.

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For all of the above reasons, claims 1-5, 7, 8 and 10-21 are in condition for allowance, and a prompt notice of allowance is earnestly solicited.

Questions are welcomed by the below-signed attorney for Applicant.

Respectfully submitted,

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